

## **REMARKS**

### **I. Introduction**

Claims 1-20 are pending in the present application. Independent claim 1 has been amended. In view of the following remarks, it is respectfully submitted that claims 1-20 are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1-6, 10-11 and 17-18 under 35 U.S.C. § 102(b)**

Claims 1-6, 10-11 and 17-18 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,963,995 ("Lang").

As regards the anticipation rejection of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flow from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

Regarding the Examiner's assertions with respect to the teachings of Lang as applied against the rejected claim 1, Applicants note that the teachings of Lang are fundamentally different from the Applicants' claimed invention. While Lang does disclose an improved multifunctional video recorder, Lang clearly does not teach or suggest that a first selection including a plurality of digitized video signals are transmitted via the network port, or that a second selection including a plurality of digitized video signals are received through the network port, as recited in amended claim 1. Lang simply does not suggest that one or more

digitized video signals may be transmitted or received via the modem (audio/video transmitter/receiver 22), since Lang merely discloses that a video signal is transmitted.

Independent of the above, Lang clearly does not teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., “facilitate designation of the digitized video signals of the second selection,” as recited in amended claim 1. Although the Examiner cites col. 7, l. 30-45; col. 8, l. 30-60; and col. 9, l. 55 – col. 10, l. 5, as teaching the above-recited feature of claim 1, the cited sections of Lang do not actually teach or suggest the claimed feature.

Independent of the above, Lang does not teach or suggest that the DVRC has a network port; instead, Lang merely discloses a modem (audio/video transmitter/receiver 22), which is connected to a conventional telephone port, whereby a video recorder is also connected to the other end. (See, e.g., column 9, lines 61-62). Therefore, the modem (audio/video transmitter/receiver 22) disclosed in Lang clearly does not constitute a network port as recited in amended claim 1, but rather the modem disclosed in Lang merely produces a point-to-point connection to a second video recorder via a telephone line, without a network being present. In view of this fundamental difference, Lang clearly does not teach or suggest that a first selection including a plurality of digitized video signals are transmitted via the network port, or that a second selection including a plurality of digitized video signals are received through the network port, as recited in amended claim 1.

For at least the foregoing reasons, claim 1 and its dependent claims 2-6 and 10-11 are not anticipated by Lang. Applicants note that claim 17 recites features substantially similar to the above-discussed features of claim 1, i.e., “a DVRC network port” and “the first DVRC is adapted to receive through the DVRC network port a selection of a digitized video signals,” so claim 17 and its dependent claim 18 are similarly not anticipated by Lang, at least for the reasons stated in connection with claim 1.

In view of all of the foregoing, withdrawal of the anticipation rejection is respectfully requested.

### **III. Rejection of Claim 7 under 35 U.S.C. § 103(a)**

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 5,930,473 (“Teng”).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

First of all, claim 7 depends on claim 1. Furthermore, the teachings of Teng simply do not remedy the deficiencies of Lang as applied against parent claim 1, i.e., Teng similarly fails to teach or suggest that a first selection including a plurality of digitized video signals are transmitted via the network port, or that a second selection including a plurality of digitized video signals are received through the network port, as well as failing to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., “facilitate designation of the digitized video signals of the second selection,” as recited in amended claim 1. For at least these reasons, dependent claim 7 is not rendered obvious by the combination of Lang and Teng.

### **IV. Rejection of Claims 8 and 9 under 35 U.S.C. § 103(a)**

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 5,666,363 (“Osakabe”).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria

must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

First of all, claims 8 and 9 ultimately depend on claim 1. Furthermore, the teachings of Osakabe simply do not remedy the deficiencies of Lang as applied against parent claim 1, i.e., Osakabe similarly fails to teach or suggest that a first selection including a plurality of digitized video signals are transmitted via the network port, or that a second selection including a plurality of digitized video signals are received through the network port, as well as failing to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., “facilitate designation of the digitized video signals of the second selection,” as recited in amended claim 1. For at least these reasons, dependent claims 8 and 9 are not rendered obvious by the combination of Lang and Osakabe.

#### **V. Rejection of Claims 12-16 under 35 U.S.C. § 103(a)**

Claims 12-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 6,330,025 (“Arazi”).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s)

must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Applicants note that claim 12 recites substantially similar features as those recited in amended claim 1. As discussed in connection with claim 1, Lang fails to teach or suggest that a first selection including a plurality of digitized video signals are transmitted via the network port, or that a second selection including a plurality of digitized video signals are received through the network port, as well as failing to teach or suggest that the DVRC stipulates the video signals of the second selection, i.e., “facilitate designation of the digitized video signals of the second selection.” In addition, Lang does not teach or suggest that the DVRC has a network port. Furthermore, the teachings of Arazi simply do not remedy the deficiencies of Lang as applied against claim 12, i.e., Arazi similarly fails to teach or suggest that a first selection including a plurality of digitized video signals are transmitted via the network port, or that a second selection including a plurality of digitized video signals are received through the network port. Accordingly, any combination of Lang and Arazi would fail to approximate the invention of claim 12.

Independent of the above, Applicants note that one of ordinary skill in the art would not be motivated to combine the teachings of Arazi with the teachings of Lang, since Lang relates to a classical video recorder which is only intended for the simultaneous processing of a single data source, and Lang does not teach or suggest anything regarding the processing of several data sources (video cameras) simultaneously. Therefore, one skilled in the art would have no reason to make the combination asserted by the Examiner.

For at least the foregoing reasons, claim 12 and its dependent claims 13-16 are not rendered obvious by the combination of Lang and Arazi.

#### **VI. Rejection of Claim 19 under 35 U.S.C. § 103(a)**

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. Patent No. 6,330,025 (“Arazi”).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28

U.S.P.Q.2d 1555, 1556 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

First of all, claim 19 depends on claim 17. Furthermore, the teachings of Arazi simply do not remedy the deficiencies of Lang as applied against parent claim 17, i.e., Arazi similarly fails to teach or suggest that a selection of digitized video signals are received via the DVRC network port, as well as failing to teach or suggest that the DVRC has a network port. For at least these reasons, claim 19 is not rendered obvious by the combination of Lang and Arazi.

#### **VII. Rejection of Claim 20 under 35 U.S.C. § 103(a)**

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of Arazi, and further in view of Osakabe.


In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1555, 1556 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 20 depends on claim 19, which in turn depends on claim 17. Furthermore, the teachings of Osakabe simply do not remedy the deficiencies of Lang and Arazi as applied against parent claims 17 and 19. Accordingly, even if one assumes for the sake of argument that there were some motivation to combine the teachings of the applied references in the manner asserted by the Examiner (with which conclusion Applicants do not agree), the asserted combination would fail to approximate the claimed invention of dependent claim 20. For at least these reasons, the combination of Lang, Arazi and Osakabe does not render obvious dependent claim 20.

### **CONCLUSION**

In view of all of the above, it is respectfully submitted that all of the presently pending claims 1-20 are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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